

Appl. No. 10/617,580
Office Action mailed March 15, 2005
Response filed June 30, 2005

Attorney Docket 10922/51

REMARKS

1. Claims 1-29 are pending in the application. The Office Action includes rejections for indefiniteness under 35 U.S.C. § 112, first paragraph, and also includes rejections in view of prior art under 35 U.S.C. § 102 (e) and also under 35 U.S.C. § 103(a). While there are no amendments to the claims in this response, a copy of the claims is included for the Examiner's convenience.

2. All rejections for prior art cite U.S. Pat. No. 6,773,448 to Kusleika et al. ("Kusleika"). Kusleika was filed on March 8, 2002, with no claim to an earlier priority date. Accordingly, the effective date of Kusleika as a reference is March 8, 2002. The present application was filed on July 11, 2003, with a claim to a priority date of a provisional application that was filed on July 12, 2002.

Applicants have filed with this Response a Statement of Prior Invention under 37 C.F.R. § 1.131, beginning on page 8. The statement of prior invention includes a statement by the Inventors that they invented the subject matter of this application before March 8, 2002. The statement also includes as an attachment a redacted invention disclosure consisting of a facsimile cover sheet and four pages of drawings. Each of the pages is dated at least once prior to March 8, 2002. The cover sheet and drawings were transmitted prior to March 8, 2002, and thus each sheet of the attachment also includes a facsimile transmission date prior to March 8, 2002.

This statement and the attachment show that the inventors invented a flexible cannula by making spiral cuts along a longitudinal axis of the cannula prior to March 8, 2002. Reasonable diligence is shown by the fact that the inventors' sketches were reduced to at least preliminary drawings with preferred sizes and dimensions for manufacturing flexible cannula prototypes. The provisional application to which the present application claims priority was filed on July 12, 2002. Accordingly, Kusleika is not available as a reference. The Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. § 102 (e) and 35 U.S.C. § 103(a).

3. Claims 2, 5, 6, and 15-17 are rejected under 35 U.S.C. § 112, first paragraph, because the word "about" in the claims is vague and renders the claims indefinite. According to M.P.E.P. 2173.05(b), at 2100-209, reference to an object that is variable may render a claim indefinite.

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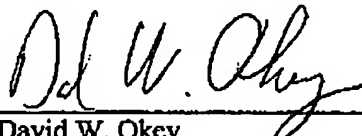
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However, when the term "about" is used with reference to something that may be measured, then the claim is not indefinite. The Court of Appeals for the Federal Circuit held that a claim term reciting "exceeding about 10% per second" to be definite because infringement could clearly be assessed by using a stopwatch. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1986). In another example, a claim term used to define the area of the lower end of a mold as between 25 to about 45% of the mold entrance was held to be clear, but flexible. *Ex parte Eastwood*, 163 U.S.P.Q. 316 (Bd. App. 1968).

In rejected Claims 2, 5, 6, and 15-17, the claim term "about" refers to numerical limitations. Under the reasoning of M.P.E.P. 2173.05(b), infringement can readily be measured, and the claims are not indefinite. Accordingly, the Examiner is respectfully requested to withdraw the rejections for indefiniteness of Claims 2, 5, 6, and 15-17 under 35 U.S.C. § 112, first paragraph.

4. Applicant respectfully requests the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned attorneys for the Applicant via telephone if such communication would expedite this application.

Respectfully submitted,



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